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Supreme Court of the United States

OCTOBER TERM 1938

No. 372.

STALEY ELEVATOR CO., INC.,

Petitioner,

and

570 BUILDING CORPORATION, SAMUEL COHEN

and JACOB C. COHEN,

Petitioners,

vs.

OTIS ELEVATOR COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT AND BRIEF IN SUPPORT THEREOF.

WILLIAM H. DAVIS,
WILLIS H. TAYLOR, JR.,
Counsel for Petitioners

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**PETITION FOR A WRIT OF CERTIORARI TO THE
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THE SECOND CIRCUIT**

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE
JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners, Staley Elevator Co., Inc., 570 Building Corporation, Samuel Cohen and Jacob C. Cohen, pray for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit, to review a decree of that

Court entered on July 29, 1938 (IV, 2049) affirming a decree of the District Court for the Eastern District of New York (IV, 2030-3) holding valid and infringed claims 1 to 29 inclusive of Larson's patent 1,694,823 granted December 11, 1928, and claims 4 to 6 inclusive, 9 to 14 inclusive, 23, 27, 28 and 76 to 84 inclusive of Lindquist et al. patent 1,904,647 granted April 18, 1933. A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved

The patents relate to "collective" automatic push-button elevators.

An automatic push-button elevator is one that may be started by pressing any one of a series of push-buttons arranged in the car and numbered to correspond to the several floors, or by any one of a series of push-buttons located at the several floor landings, and is automatically stopped at the desired floor; that is, at the floor corresponding to the numbered push-button selected and pressed by a passenger in the car, or at the floor landing at which a prospective passenger has pressed a push-button to call the car. A "collective" automatic push-button elevator is one that has provision for registering a number of calls and deferring the response to them, so that when buttons corresponding to different floors are pushed the car will proceed on its journey, automatically stopping at the several floors in the order in which the floors are reached, irrespective of the sequence in which the buttons have been pressed, and restarting to respond to the deferred calls after each stop.

In Larson's patent (III, 1166) there is but one push-button at each floor landing and consequently the prospective

passenger has no way to indicate whether he wants to go up or down. As soon as the car comes from either direction to a landing at which a button has been pressed, it will automatically stop, without regard to the desired direction of travel of the prospective passenger. For instance, if a prospective passenger at some floor landing wants to go down and presses the button at that landing when the car is below that landing but on its way up, the car will stop on its up journey and if the passenger gets in he will be carried up to the end of the up journey before he is taken down.

The Lindquist et al. patent (III, 1192) has two push-buttons at each floor landing—one for "up" and one for "down" travel. The up and down buttons are arranged in separate registering circuits so that the elevator car collects only the "up" calls on the up journey and the "down" calls on the down journey.

The elevator art has long included two types of elevators: (1) "car switch operated" elevators and (2) automatic push-button elevators.

A car switch-elevator is operated by an attendant through a hand switch in the car which controls the starting and the stopping of the car. The starting and the stopping are wholly at the will of the elevator attendant.

The old automatic push-button elevator (most widely used in clubs and private dwellings and referred to in this record and in the opinion of the Court of Appeals as the SOB system) was not "collective". It was started by pressing any one of the push-buttons in the car or any one of the push-buttons at the several floor landings; and it was automatically stopped at the desired floor; but it did not register the calls or defer the response. The passenger who first pushed a button obtained and retained control of the car until he had completed his journey. In the meantime, all calls subsequent to his were rendered

ineffective. The control circuits of all the other push-buttons were interrupted until the car was released by the first passenger.

In January, 1922, prior to the filing of either of the patents in suit, one Parker brought to the attention of respondent, Otis Elevator-Company, his pending application for a patent filed April, 1921 (prior to any date available to either of the suit patents here involved), describing an automatic push-button "stop control" as applied to a "car switch" type elevator. Parker's system provided push-buttons in the car, one for each floor, and "up" and "down" buttons at each floor landing. In the Parker system, the "stops" are "collective". That is, they are registered and deferred so that if a number of buttons corresponding to different floors are pressed the car will automatically stop at the several floors in the order in which the floors are reached, irrespective of the sequence in which the buttons have been pressed. The mechanism, with all its electrical circuits, is called a "floor selector".

Because Parker had an "up" and a "down" button at each landing, arranged in separate registering circuits, his car responds to (collects) only the "up" calls on the up journey and the "down" calls on the down journey.

In the system disclosed in Parker's patent the automatic stop control is applied to a car switch elevator. The starting is wholly within the control of the attendant.

Parker, in January, 1922, explained his automatic push-button stopping system to Mr. Lindquist, chief engineer of respondent (and one of the joint applicants of the Lindquist patent), and left with Mr. Lindquist a copy of the Parker patent application and drawings (I, 297). Respondent proceeded to install, in the Standard Oil building at 26 Broadway, New York City, an elevator in accordance with the Parker system. Work on this installation was under

way prior to April, 1922 (I, 355)—prior to the filing dates of the Larson and Lindquist patents.

The Parker patent issued on August 26, 1924 (III, 1390) and, subsequent to the completion of the installation in the Standard Oil building, was purchased by respondent in 1925. As issued the Parker patent claims were limited to an elevator system in which the Parker automatic stop system was applied to a car switch type elevator (IV, 1690). Respondent, through its Patent Department, reissued the patent (Reissue 16,297, III, 1390) to cover the application of Parker's control to all elevators, without regard to the kind of starting control employed.

Thereafter respondent prosecuted and obtained in the Larson patent claims for applying Parker's control to a "one button per floor" automatic push-button elevator system; and then the Lindquist patent for applying Parker's control to an "up and down two button per floor" automatic push-button elevator system. In this way respondent's monopoly of Parker's idea was extended, with respect to automatic push-button elevator systems, at first, by Larson's patent, to 1945, and then, by the Lindquist patent, to 1950.

The scope of the monopoly claimed in the two patents in suit is not confined to any particular arrangement of circuits by means of which calls are registered, sifted and responded to, or by which the starting and stopping of the car is controlled.*

To these claims your petitioner interposed the defenses of lack of invention and non-infringement.

The Court of Appeals said (IV, 2054): "In effect the patents in suit combine the 'floor selector' mechanism of the Parker system with the starting and direction-determining mechanism of the old SOB system", but the court re-

*See typical claims set forth in opinion of Court of Appeals (IV, 2050-51).

jected the defense of no invention (IV, 2054-5) as insufficiently proved in view of the complexity of the electrical circuits which control the car movements and because the "burden was upon the appellants to rebut the presumption of validity arising from the issuance of the patents by the Patent Office, which had before it the Parker reference. They have not carried that burden."

Although a patentee is required, by Revised Statutes, Section 4888,* "in case of a machine" to "explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions" Larson's patent does not do that. When the Larson patent is read with the knowledge which respondent possessed as to the nature and applicability of Parker's invention, it shows a deliberate omission to comply with the statutory requirement.

The Larson patent (III, 1166) explains that there are "at least two types of electric elevators: one known as a car switch operated elevator which is operated by the operator of the car; and the other a push-button automatic elevator which is controlled by the pushing of buttons corresponding to the floors served by the elevator" (ls. 7-14);

*R. S. 4888, c. 94, Sec. 1, 38 Stat. 958. *Application for patent; description; specification and claim.* Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of non-compliance with this section if the description is made as complete as is reasonably possible.

and goes on to point out that running past intermediate floors at which passengers might have been discharged or prospective passengers might have gotten on is a fault common to car switch operated elevators and push-button automatic elevators alike—that, "In brief the operation of the prior art push-button elevator for more than two floors is in the respect written about open to the same objection made to the car switch elevator" (III, 1166, ls. 15-27 and 1166, 99 to 1167, l. 13).

Although respondent, by whom the Larson application was filed and prosecuted, knew that Parker had already overcome the objectionable running past intermediate floors by providing automatic mechanism for causing the elevator to obey all stop signals, and had applied that remedy to cure the fault in car switch operated elevators, the patent specification says nothing about that. The language of the specification is (III, 1167, ls. 26 et seq.) "It is the object of my invention to produce such a *push-button elevator* . . . which will . . . invariably obey the signals . . .". The Patent Office was not told that this limited object, to cure one half the recited fault in elevator operation, was achieved merely by applying to automatic push-button elevators the same cure that Parker had already applied to the other half of the same fault in car switch operated elevators.

This failure to advise the Patent Office of the truth with respect to the prior art, deprived the Patent Office of all fair opportunity to judge whether invention was involved.

The claims of the Lindquist et al. patent (which, under the decision of the Court of Appeals, further extend the monopoly with respect to automatic push-button elevators) are predicated solely upon the fact that Lindquist et al. substituted for Larson's single floor buttons, Parker's arrangement of the two buttons, an "up" button and a "down" button at each floor. In this patent too there is no compliance with the requirement of Section 4888.

Reasons Relied on for Allowance of Writ

The discretionary power of this Court to grant a writ of certiorari is invoked upon the ground that there is here involved an important question of patent law that has been decided in a way which is untenable or in conflict with the weight of authority and against the great interest (a) of all those members of the public who are interested in making, buying or using automatic push-button elevators and (b) of the public in general which would be adversely affected by the precedent of the instant case, namely:

(1) The decision of the Court of Appeals holding Larson's patent valid and infringed, prolongs respondent's monopoly under the Parker reissued patent (when used in automatic push-button elevators) from March 23, 1943, the date of expiration of the Parker reissue to December 11, 1945, and similarly the decision holding valid and infringed the Lindquist et al. patent further prolongs the monopoly to April 18, 1950; in contravention of the rule that the application of an old machine or instrumentality to a new and analogous use is not invention.*

(2) The decision of the Court of Appeals holding Larson's patent valid and infringed, upon the ground that Larson had to overcome complexities of electrical circuit connections in order to apply Parker's stop control to an automatic push-button elevator, erroneously upholds a broad monopoly, not for some particular means of overcoming such complexity, but for any and all means of applying Parker's stop control to automatic push-button elevators; in contravention of the established rule that a patent cannot validly be granted, even to one who first attains a desired end, for all means of attaining that end.**

*See cases cited in the brief accompanying this Petition.

***Holland Furniture v. Perkins Glue Co.*, 277 U. S. 245, 257 and cases there cited.

(3) The Court of Appeals further erred in sustaining the claims of the Lindquist et al. patent in contravention of the well-established rule that one who has substituted for one of the parts of an old combination a different part (even a novel one), cannot lawfully claim that part in combination with other old parts which perform no new function in the combination.*

WHEREFORE, your petitioners respectfully pray that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the decree of the Circuit Court of Appeals be reversed; and that petitioners be granted such other and further relief as may be proper.

WILLIAM H. DAVIS,
WILLIS H. TAYLOR, JR.,
Counsel for Petitioners.

Dated, September 22, 1938.

**Lincoln, etc., Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549, 550 and cases there cited.

BRIEF IN SUPPORT OF THE PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the District Court for the Eastern District of New York, written by Judge Moskowitz, appears at page 1970, Vol. IV, of the record. It is reported at 35 U. S. P. Q. 420. The opinion of the Circuit Court of Appeals for the Second Circuit (Circuit Judges Marrow, Swan and Chase), written by Judge Swan, appears at page 2049, Vol. IV, of the record. It has not been reported.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. C., sec. 347). Cases believed to sustain the jurisdiction are *DeForest Radio Co. v. General Electric Co.*, 283 U. S. 664; *Carbice Corp. of Am. v. American Patents Development Corp., et al.*, 283 U. S. 27; and *Simmons v. Greer*, 258 U. S. 82.

The decree of the Circuit Court of Appeals which petitioners seek to have reviewed was entered July 29, 1938 (IV, 2049). Thereafter, a petition for rehearing was filed, which was denied on August 30, 1938 (R. IV, 2094-5).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for writ of certiorari and need not be repeated here.

Specification of Errors

If the writ of certiorari is issued, petitioners intend to urge that the Circuit Court of Appeals for the Second Circuit erred:

- (1) In holding valid and infringed Claims 1-29, inclusive, of the Larson suit patent, and Claims 4-6, 9-14, 23, 27, 28, and 76-84, inclusive, of the Lindquist suit patent.
- (2) In affirming the decree of the District Court holding the Larson and Lindquist suit patents valid and infringed.

Argument

In holding valid and infringed the claims of Larson's patent upon which respondent relies (claims 1 to 29 inclusive) the Court of Appeals approved the prolongation of respondent's monopoly of Parker's automatic stop-control (when used in automatic push-button elevators) in contravention of the rule that the application of an old machine or instrumentality to a new and analogous use is not invention.*

Neither one of the patents had been adjudicated before, and there is accordingly no conflict of decisions as to their validity. The primary grounds for certiorari are that the

**Phillips v. Page*, 24 How. 164, 167; *Brown v. Piper*, 91 U. S. 37, 41, *Roberts v. Ryer*, 91 U. S. 150, 157; *Planing Machine v. Keith*, 101 U. S. 479, 491; *Heald v. Rice*, 104 U. S. 737, 754-756; *Atlantic Works v. Brady*, 107 U. S. 192; *Pennsylvania, etc., Co. v. Locomotive, etc., Co.*, 110 U. S. 490, 494; *Morris v. McMullen*, 112 U. S. 244, 248; *Thatcher v. Burtis*, 121 U. S. 286, 294-5; *Consolidated Roller Mill Co. v. Walker*, 138 U. S. 124, 131-133; *Ansonia v. Electrical Supply Co.*, 144 U. S. 11, 17-18; *Pope v. Gormully & Jeffery*, 144 U. S. 254, 259-260; *Mast, Foos v. Stover*, 177 U. S. 485, 492-3; *Concrete Appliances v. Gomery*, 269 U. S. 177, 184-5; and *Powers Kennedy v. Concrete Co.*, 282 U. S. 175, 186-7.

decision of the Court below is based upon error apparent on the face of its opinion, and that the correction of such error is not merely of concern to petitioners, but is (a) of vital importance to all of the some hundred independent manufacturers of automatic push-button elevators throughout the United States, and (b) of great importance to the public in general which would be adversely affected by the precedent of the instant case, which substantially breaks down the rule that a patent may not validly be granted for the new use of an old machine within the field of its inherent utility, even though that new use and its effect had not before been contemplated.

Respondent, Otis Elevator Company, and Westinghouse Electric & Mfg. Company, its largest competitor, have pooled their competitive patents (IV, 1807-10), including the Larson and Lindquist patents here involved, providing in an agreement dated September 3, 1935 that (IV, 1809):

"neither will assert against the other nor its respective vendees or customers any United States patent that now or at any time during the life of this Agreement [1950] is owned or controlled by it", etc.

And the agreement further provides that the parties will report to one another in writing all contracts of sale within the scope of the agreement, together with "the number and type of elevators and change-overs involved, the contract price, the address of the installation and the date of the contract" (IV, 1808, f. 5424).

Thus, respondent and the Westinghouse Company are now in a position to *effectively monopolize* the entire *modern* "collective" automatic push-button elevator industry; and doubtless without further litigation, since no small manufacturer could reasonably be expected to finance such litigation under existing circumstances.

That the use of Parker's automatic push-button stop control on the old automatic push-button type of elevator

is analogous to its use, as disclosed by Parker, on the old car switch type of elevator is apparent.

It is made quite clear in the specification of Larson's patent; which correctly recites the common fault (running past intermediate floors at which passengers might have been discharged or prospective passengers might have gotten on) of car switch operated elevators and push-button automatic elevators alike, and says that "the operation of the prior art push button elevator for more than two floors is in the respect written about open to the same objection made to the car switch elevator". (III, 1167, ls. 9-13).

The Court of Appeals, impressed with the complication of the electrical circuit diagrams of such elevator systems, held that your petitioner had not sufficiently proved that it did not require invention (more than mere engineering skill) to *devise the circuit arrangements* by which Larson combined the Parker automatic stopping system with the starting and direction-determining mechanism of the old SOB system.

Even if the Court of Appeals was right in attributing this significance to the complexity of the electrical circuits*

*The fact is that all these complexities, impressive as they are, when one tries to trace the multiplex circuits, had been reduced to simple order in the prior art. The "starting and direction-determining mechanism" of the old SOB system, which was standard equipment, so reduced to order the starting and direction-determining circuits. The old "floor selector" mechanism of the Parker system likewise reduced to order the circuit connections which register and defer the stop signals so that the elevator, in its journeys, will stop as it reaches any floor where a stop signal button had been pressed, regardless of the disorderly sequence in which the several buttons were pressed by the passengers and prospective passengers. When Larson, for the purpose of applying Parker's stop control to the old push-button automatic system, proceeded to "combine the 'floor selector' mechanism of the Parker system with the starting and direction-determining mechanism of the old SOB system" (opinion of the Court of Appeals, IV, 2054) all of the complexity was taken care of, and eliminated so far as he was concerned, within the "floor selector" and the "starting and direction-determining mechanism of the old SOB system". The recital by the Court of

the decision of the Court would nevertheless be erroneous. Claims of the scope sustained cannot be maintained on the basis that inventive ingenuity was required to work out and establish such circuit connections. Such claims could justly be based only upon a finding that the *conception of the idea of applying Parker's automatic stop control to an automatic push-button elevator system involved invention*. Only if the extension of the use had been to a non-analogous field; one that would not suggest itself by necessity of human reasoning to anyone familiar with Parker's idea.

No such suggestion could be made. It is negated by the fact that respondent reissued the Parker patent to add claims broad enough to embrace the application of Parker's system to an automatic push-button elevator system, and has expressly charged that petitioner's system accused in this suit is also an infringement of the Parker patent so reissued (Ex. O, III, 1434). This suggestion is also negated by the fact that in the Larson application as originally filed respondent included claims broad enough to embrace the application of the automatic stopping system to all types of elevators.

(Footnote continued from previous page.)

Appeals of specific complexities (opinion, IV, 2054-5) includes not one that was not overcome in the Parker "floor selector". That instrumentality, as the Parker patent shows, had "three buttons for each floor, two in the hall and one in the car" and the signals were "properly sifted so that the car responds to all calls during one round trip up and down the shaft", etc.; and they were "held in abeyance * * * until all intermediate calls in that direction had been responded to", etc. And the operation of stopping the car at a floor level, which the Court of Appeals refers to as "complex" (IV, 2055) was all within the arrangement and disclosure of Parker's patent.

*For example, claim 13, Exhibit 10, page 36 reads as follows:

"13. A control system for an elevator car comprising, a switch for each floor, and means responsive to the operation of said switches for stopping the car at the floors corresponding to the switches operated in the natural order of floors, though said switches are operated out of said order."

Indeed, the general applicability of Parker's automatic stopping system to all types of elevators is inherent in the very conception of the system. Just as much so as the application of an automatic stop to through passenger trains as well as to local freight trains is inherent in the conception of an automatic train stop; or the application of a method of freezing is inherently applicable to the preservation of fish as well as to the preservation of meat.*

If it be assumed that the Court of Appeals was correct in supposing that the application of Parker's automatic stop system to the old SOB automatic push-button elevators involved wiring difficulties which required inventive ingenuity to overcome, that might afford the basis for a valid patent predicated upon the overcoming of that particular difficulty. In that case we should expect to find in Larson's patent a description of the particular wiring difficulty, and of his means of overcoming it, and specific claims might be sustained for that. It might be that the specific claims not relied on in this case are of that character, but those specific claims were not brought into the litigation because petitioner does not by any means use the specific circuit connections devised by Larson.

The claims which are relied upon, and which it is charged that petitioner has infringed, cover broadly, and without reference to particular circuit connections, the application of Parker's idea to an automatic push-button elevator system. They cover all means for attaining Larson's purpose to apply Parker's system to a push-button automatic elevator. A purpose, or end, which was inherent in the very idea of Parker's automatic stop control. A valid patent cannot be granted, even to one who first attains a desired end, for all means of attaining that end; because such a grant is broader than the field of the patentee's inventive effort and gives him monopoly of fields into which he has

**Brown v. Piper*, 91 U. S. 37.

not entered and in which other inventors are as free to work as he was. To sustain such patents would retard rather than promote the progress of science and useful arts.*

The Court of Appeals was equally in error, with respect to the Larson patent, in resting its decision upon the "presumption of validity arising from the issuance of the patent[s] by the Patent Office, which had before it the Parker reference." (opinion IV, 2055) Although Parker's patent was cited by the Patent Office against claims of Larson's application (such as claim 13 quoted above) which broadly claimed the application of the automatic stop to all kinds of elevators; yet Larson (and respondent) consciously and deliberately omitted to comply with the statutory requirement that he must explain the principle of the alleged invention "so as to distinguish it from other inventions"; and never brought home to the patent office that Larson's asserted invention was no more than the application of Parker's system to the old automatic push-button SOB system.

There is much authority for declaring the Larson patent invalid on the single ground that it did not comply with the statutory requirement.** But, beyond this, respondent's conduct in preparing Larson's specification and prosecuting the patent deprived the public (including petitioner) and the courts of all aid from the patent specification in determining what the supposed invention really was; how it differed from what was already known, and whether the application of Parker's automatic stopping

**Holland Furniture v. Perkins Glue Co.*, 277 U. S. 245, 257 and cases there cited.

***Evans v. Eaton*, 7 Wheat. 356, 434-5; *Merrill v. Yeomans*, 94 U. S. 568, 570; *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274, 278; *Barrett v. Hall*, 2 Fed. Cas. 914, 924; *Hovey v. Stevens*, 12 Fed. Cas. 615, 618; *Lowell v. Lewis*, 15 Fed. Cas. 1018, 1020; *Jacobs v. Almond*, 177 Fed. 935, 936, C. C. A. 2; *Steel Wheel Corp. v. B. F. Goodrich*, 27 F. (2d) 427, 431, D. C., E. D. Mich., aff. 42 F. (2d) 406.

means to a push-button elevator (instead of to a car switch operated elevator as disclosed by Parker) required any inventive ingenuity beyond the expected skill of an elevator engineer; and it also deprived the patent office of all fair opportunity to judge whether invention was involved. For these reasons, the validity of the patent is without the *prima facie* presumption that ordinarily arises from the grant of a patent by the patent office.*

In holding valid and infringed the claims of the Lindquist *et al* patent upon which respondent relies (claims 4 to 6, inclusive, 9 to 14, inclusive, 23, 27, 28 and 76 to 84, inclusive) the Court of Appeals further approved the prolongation of respondent's monopoly of Parker's automatic stop control (when used in automatic push-button elevators) in contravention of the rule that the application of an old machine or instrumentality to a new and analogous use is not invention.

And the Court further violated the established rule that one who has substituted for one part of a known machine or apparatus, another part (even a novel one), cannot start afresh claiming over again the old machine or apparatus.**

As to the claims of the Lindquist *et al* patents, which are charged to be infringed, they are predicated solely on the fact that Lindquist *et al* substituted for the single push-button at each floor landing, in the Larson patent, the two push-buttons, an "up" button and a "down" button, which were found in Parker's automatic stop control. The effect, and the only effect, of this was to separate the push-button registering circuits, in precisely the same way and

**Rogers v. Fitch*, 81 Fed. 959, 961-2, C. C. A. 2; *Fruehauf Trailer v. Highway*, 54 F. (2d) 691, 692-4, D. C., E. D. Mich., S. D.; *Goodbody v. Firestone*, 23 F. (2d) 625, 626, C. C. A. 6; *Black & Decker v. Baltimore Truck*, 26 F. (2d) 686, 689, D. C., D. Md.

***Lincoln, etc., Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549, 550 and cases there cited.

for precisely the same purpose that they were separated in Parker so that the elevator car would respond to (collect) only the "up" calls on the up journey and the "down" calls on the down journey.

There is nothing in the opinion of the Court of Appeals to indicate why this was supposed to amount to invention. It is not suggested that the circuit arrangements used by Lindquist *et al* for this purpose are any different from the circuit arrangements used by Parker for the same purpose. There is no suggestion in the patent or elsewhere that this substitute in the system of one of arrangements of floor buttons for another presented any difficulty or that it was motivated by any other purpose than to incorporate in the Lindquist *et al* system the same advantages that an "up" button and a "down" button at each floor gave to the Parker system. The claims relied upon, of which claim 11 is typical are thus invalid for lack of invention.

These claims are furthermore invalid for another reason. They assume to represent that the patentees produced a new combination, when in fact all they have done is to substitute for one hall button element of the old combination (Larson's single buttons) another old hall button arrangement (Parker's "up" and "down" buttons). Under those circumstances, on the authority of an old and well established rule of the patent law, the claims are invalid. They would be invalid for that reason even if the substituted element were in itself new.*

No one should know this better than respondent Otis Elevator Company, since in *Otis Elevator Co. v. Portland Co.*, 127 Fed. 557, the 1st Circuit Court of Appeals said (p. 561):

**Lincoln, etc., Co. v. Stewart-Warner*, 303 U. S. 545, 549-50; *Perry v. Co-Operative Foundry*, 12 Fed. 436, 438, C. C. N. D., N. Y.; *McGrath v. Ansell*, 58 F. (2d) 205, C. C. A. 2; *Langan v. Warren Axe & Tool Co.*, 184 Fed. 720, 721, C. C. A. 3; *Radio Corp. v. Lord*, 28 F. (2d) 257, 260, C. C. A. 3; *Kodel v. Warren*, 62 F. (2d) 692, 694, C. C. A. 6; *Backstay v. Zenite*, 293 Fed. 23, 24, C. C. A. 7; *Dixie-Vortex Co. v. Lily Tulip Cup Corp.*, 37 U. S. Pat. Q. 158, 161, C. C. A. 2.

"The patentee cannot subsequently start afresh and say: 'I have now another machine, which is exactly like the old one in the use of the generic idea. I desire a patent upon it, but I do not claim the feature in which the machine of my new application differs from the old, but I claim what is exactly the same as is in the old. I claim that machine again, and all others containing the same invention.' Yet this is substantially the case before us." (127 Fed. 561.)

Conclusion

We respectfully submit, therefore, that under the circumstances and for the reasons stated in the petition and elaborated in the brief, the petition should be granted.

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